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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,198	05/14/2001	Rudolf H. Aebersold	P-IS 4693	2506

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CAMPBELL & FLORES LLP
4370 LA JOLLA VILLAGE DRIVE
7TH FLOOR
SAN DIEGO, CA 92122

EXAMINER

CEPERLEY, MARY

ART UNIT PAPER NUMBER

1641

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/858,198

Applicant(s)

AEBERSOLD ET AL.

Examiner

Mary (Molly) E. Ceperley

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 76-142 is/are pending in the application.
- 4a) Of the above claim(s) 87-89,91,100-102,104 and 141 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 76-86,90,92-99,103,105-140 and 142 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1) The July 07, 2003 request for a change of inventorship under 37 CFR 1.48(s)(2) involving statements submitted under 37 CFR 3.73(b) and 1.48(a)(5) is denied due to the following omissions:

a) The statement filed under 37 CFR 3.73(b) {statement regarding assignment} by the assignee Applera Corp. states that Applera is a co-assignee of this application with both the Institute for Systems Biology and the University of Washington. However, statements regarding assignment have not been filed by the co-assignees Institute for Systems Biology, originally the sole assignee, and the University of Washington.

b) A statement under 37 CFR 1.48(a)(5) {agreement to change in inventorship} has been filed by the Institute for Systems Biology. However, statements under this rule have not been filed by the co-assignees University of Washington and Applera.

2) Newly submitted claim 141 is withdrawn from consideration as being directed to an invention that is independent or distinct from the invention originally elected and examined for the following reason: this claim is directed to a method of use corresponding to original claim 1 (Invention I) which is a non-elected invention {see the reasons for restriction set forth in paragraph **2)a)** of the August 16, 2002 Office action}.

Since applicant has received an action on the merits for the originally elected Invention II, this invention has been constructively elected for prosecution on the merits. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 76-86, 90, 92-99, 103, 105-140 and 142, drawn to the elected invention, are treated on the merits in this Office action. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3) Although specific claims are cited in the rejections below, these rejections are also applicable to all other claims in which the noted problems/language occur.

Art Unit: 1641

4) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5) Claims 121-140 and 142 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) The reference to "Figure 1" renders the claims indefinite for the following reasons. First, it is unclear which of the two structures shown in Figure 1 is being referred to. Second, for clarity purposes, the appropriate structure of Figure 1 should be incorporated into the claims especially since it is unclear which portion of the depicted structure of Figure 1 constitutes "the cleavable functional group, tag and reactive group" (e.g. claim 121); the filled in circle of the structure (solid support) should also be identified. Note also, that the "isotope tag" of claims 121, 138 and 142 does not appear in the structure of Figure 1.

b) Claim 142 is indefinite for the reason that it is unclear what is intended by the term "compounds" relative to the word "composition" used in all the other claims. Further, a chemical "compound" conventionally does not contain a "solid support".

6) Claim 142 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no written support in the specification for the "pair of compounds" of claim 142. The portions of the specification and claims cited as support in the first paragraph of page 9 of the July 19, 2004 response do not, in fact, support claim 142.

Art Unit: 1641

7) Claims 76-86, 90, 92-99, 103, 105-120, 128-137 and 142 are rejected under 35 U.S.C. 112, first paragraph, for the reason stated in paragraph 5) of the April 07, 2004 Office action, namely that the specification does not enable the skilled artisan to make and use the invention commensurate in scope with the claims.

Applicant's arguments filed July 19, 2004 have been fully considered but they are not persuasive. At page 12 of the response, applicant states that the specification provides a "sufficient description and guidance for the enablement of" the terms "cleavable functional groups", "tags" and "reactive groups". However, while the specification contains an extensive listing of definitions of the terms in question, enablement commensurate in scope with the claims for how to make and use all of the described compositions is lacking. Other than for the particular combination of moieties of Figure 1, there is no description of how to prepare and use the myriad other combinations of "cleavable functional groups", "tags" and "reactive groups" encompassed by the claims. As pointed out by example in the last five lines of the second subparagraph of paragraph 5) of the April 07, 2004 Office action, and not addressed by applicant, very different chemistries are involved depending upon the functional groups and structures of any particular combination of "cleavable functional group", "tag" and "reactive group".

8) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1641


9) For questions regarding Patent Term Adjustment, call the Office of Patent Legal Administration at (703) 305-1383.

10) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (571) 272-0813. The examiner can normally be reached from 8 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 28, 2004


Mary (Molly) E. Ceperley
Primary Examiner
Art Unit 1641